

Claim 1 is directed to a method for specifying a selection of content segments stored in different formats. The claim recites that the first content is stored in a first format in a first storage medium and the second content is stored in a second format in a second storage medium that is a slower access storage medium than the first storage medium.

The Examiner acknowledges that Mills does not disclose the above recited feature, however, the Examiner relies upon Koyata to remedy that deficiency in Mills. Specifically, Koyata is cited for teaching a reproducing apparatus in which selected programs recorded in a first record medium are reproduced and recorded in a second recording medium. See pages 3-4 of the Office Action.

Koyata discloses a device that allows a user to easily select a program to be copied from a first recording medium to a second recording medium, such as when performing a dubbing operation or an editing operation. See col. 1 lines 8-14 and col. 2 lines 28-32. More specifically, Koyata describes a system for copying program information, such as audio files from a CD changer to a minidisk (MD) player. This is shown in figure 3 and discussed in col. 10 beginning at line 8. Koyata, in figure 3, shows a first window 11 displaying program name and ID information from a disc and a second window 12 displaying program name and ID information from another source, such as another CD. A user, intending to copy programs from each of the CD's onto the MD player, selects a program name from either the first or second window and drags and drops the selected program into the third window 13. After the user completes the selection operation, the system initiates a recording process to record the selected programs onto the MD recorder. See col. 10 lines 54-63 and col. 2, line 41- col. 3, line 4.

Mills is directed to an editing apparatus that digitizes selected video segments into multiple digitized clips. In Mills, a clip edit window 22 shown in Fig. 2, simultaneously displays such multiple digitized clips, each of which includes a begin frame 40 and an end frame 42. These digitized clips are small versions of the video frame 36 shown in video window 20. Mills discloses that these small digitized clips are used to mark a particular video frame or portion of video information for editing purposes. See col. 4 lines 29-30. Mills describes that the video frame 36 comes from a video source to be edited. The display shown in Fig. 2, from Mills' editing system, receives video information from a video source for editing. A user edits the video information using the editing system and the editing system outputs the edited or customized video information back to the video source. See col. 3 lines 33-36.

In the Office Action, it is asserted that Mills discloses each of the elements of claim 1 except for disclosing that content is stored in a second format in a second storage medium which is a slower access storage medium than the first storage medium in which the first content is stored. The Examiner asserts that the first content recited in claim 1 is disclosed by Mills' video frame 36 shown in Fig. 2, and that the specification of a plurality of portions of the first content corresponds to Mills' clip edit window 22. The Examiner asserts that the claimed content stored in a second format corresponds to the video clips shown in edit windows 38.

It is respectfully submitted that the asserted combination does not render claim 1 unpatentable for at least the following reasons. First, even if Mills were modified based on Koyata to record the output of Mills' edit system onto a MD player, tape or other medium, all the limitations of the claim would not be met. For example, Mills does not disclose that the small

digitized frames (SDF) shown in figure 2 in the clip edit window 22 are stored outside of the editing system. Rather, Mills discloses that the customized video information produced by the editing system is stored back to the video storage which is where the video frame 36 is stored. See col. 3 lines 29-36. Accordingly, even if Mills were modified to connect to a MD player or a tape device, the combination would not store the SDF frames shown in clip edit window 22 to such a device. This is because Mills does not disclose storing the frames in the clip edit window 22 outside of the edit station. Rather, the edited, or customized, video frame 36 is stored outside of the editing system, back in the video source.

Second, it is respectfully submitted that a person of ordinary skill in the art would not have been motivated to modify Mills based on Koyata as asserted in the office action. Nothing in the prior art suggests storing the SDF frames shown in the clip edit window 22 as second content to be stored in the storage medium with slower access than the storage medium from where the video frame 36 is stored. In fact doing is likely to cause the Mills system to operate slower than it would otherwise. Accordingly, it is respectfully submitted that a person of ordinary skill in the art would not have been motivated to make the asserted combination.

Therefore, Mills and Koyata, whether taken separately or as a whole, do not teach or suggest that the first content is stored in a first storage medium and the second content is stored in a second storage medium wherein the second storage medium is a slower access storage medium than the first storage medium, as recited in claim 1.

Claim 1 is patentable at least for the above reasons. Claims 2 and 8 are patentable at least because of their dependency from claim 1.

Claims 3-7, 11-15 and 19-23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mills in view of Koyata and further in view of Fujita (US 6,321,024).

Claims 3-7 are patentable at least because of their dependency from claim 1 and because Fujita does not remedy the deficiencies of Mills and Koyata with respect to claim 1. Claims 11-15 and 19-23, which include similar features to those of claim 1 discussed above, are patentable at least for the reasons analogous to these provided for claim 1 and because Fujita does not remedy the deficiencies of Mills and Koyata with respect to claim 1.

Claims 9, 10, 16-18 and 24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mills in view of Koyata and further in view of alleged Official Notice that it is well known in the art to embody inventions in software to be executed by computer. These claims, which recite similar features to those of claim 1 discussed above, are patentable at least for the reasons analogous to those provided for claim 1 and because the alleged Official Notice does not remedy the deficiencies of Mills and Koyata with respect to claim 1.

Claim 25 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Mills in view of Koyata and further in view of Langford (US 5,206,929). Claim 25 is patentable at least because of its dependency from claim 1 and because Langford does not remedy the deficiencies of Mills and Koyata with respect to claim 1.

Claims 26 and 27 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mills in view of Koyata and further in view of alleged Official Notice and further in view of Langford. The Examiner does not specify the alleged Official Notice. Applicants infer from the obviousness rejections of the respective base claims of claims 26 and 27, *i.e.* claims 9 and 17,

that the Examiner takes the alleged Official Notice that it is well known in the art to embody inventions in software to be executed by computer.


Claims 26 and 27, which recite limitations similar to those of claim 1 discussed above, are patentable at least for the reasons analogous to these provided for claim 1 and because the alleged Official Notice and Langford do not remedy the deficiencies of Mills and Koyata with respect to claim 1.

**Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

  
J. Warren Lytle, Jr.  
Registration No. 39,283

SUGHRUE MION, PLLC  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

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